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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/819,965	03/28/2001	Takao Yoshimine	275745US6	4221

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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C.
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EXAMINER	
CHAMPAGNE, DONALD	
ART UNIT	PAPER NUMBER
3688	

NOTIFICATION DATE	DELIVERY MODE
04/08/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	09/819,965	YOSHIMINE ET AL.	
	Examiner	Art Unit	
	Donald L. Champagne	3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 November 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *37-40, 48-51, 59-62, and 97-106* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *37-40,48-51,59-62 and 97-106* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *28 March 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 37-40, 48-51, 59-62, and 97-106 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In each independent claim 37, 48, 59 and 97, the following is new matter: "self-distributed by a user of the personal computer" (e.g., at claim 48, lines 2-3) and "predetermined information separate from the content data" (e.g., at claim 48, line 3).

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 37-40, 48-51, 59-62, and 97-106 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In each of the four independent claims independent claim 37, 48, 59 and 97, the following terms are indefinite:

"self-distributed by a user of the personal computer" (e.g., at claim 48, lines 2-3); it is not clear how "self-distributing" is functionally different from "distributing"; and

"predetermined information separate from the content data" (e.g., at claim 48, line 3); separate how? In time, in space?

Claim Rejections - 35 USC § 102 and 35 USC § 103

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 37-39, 48-50, 59-61 and 97-106 are rejected under 35 U.S.C. 102(b) as being anticipated by Griebenow et al. (US005850520A, hereafter Griebenow).

8. Griebenow teaches (independent claims 37, 48, 59 and 97) an apparatus, method and computer readable storage medium, the method (claim 48) comprising:

receiving from a personal computer (*publisher's computer **14***, col. 3 lines 24-26) via internet (col. 2 lines 56-65), content data distributed/self-distributed by a user of the *publisher's computer **14***/personal computer (inherently, since the computer cannot act by itself) and predetermined information including at least category information defining a genre of the content data (*bicycling*, col. 7 lines 39-41);

receiving a request (*consumer order*, col. 3 line 65 to col. 4 line 5) from one or more user locations (*consumer's computer **12***) for selected content data, the request (inherently) including information specifying content data to be transmitted;

referring to on-demand schedule control information (*an order event*, col. 4 lines 20-28) based on the information specifying content data to be transmitted and retrieving the selected content data (col. 4 lines 32-34);

transmitting, via a network, the selected content data to one or more user locations (col. 4 lines 34-45) along with a commercial (*customized advertising*) selected in accordance with the on-demand schedule control information (col. 7 lines 21-49 and *advertising timing*, col. 10 lines 34-41); and

the consumer ordering a publication dealing with a specific subject (col. 7 lines 33-36), other than *bicycling*, which reads changing the information defining genre (e.g., *bicycling*) of

the content data through the personal computer after receiving the predetermined information (col. 6 lines 63-65 and col. 7 lines 23-49).

9. The following claim language is non-functional descriptive material and was not given patentable weight (MPEP § 2106.01): predetermined information "separate from the content data". This claim language is not functional because it does not alter how the process steps are to be performed to achieve the utility of the invention. Said "separate" predetermined information is functionally indistinguishable from the content data.

10. Griebenow also teaches at the citations given above claims 99-102.

11. Griebenow also teaches claims 38, 39, 49, 50, 60 and 61 (col. 10 lines 21-25); claim 98 (at the citations given above and col. 6 lines 43-58, where *web page* reads on "URL"); and claims 103-106 (col. 10 lines 58-65).

12. Claims 40, 51 and 62 are rejected under 35 U.S.C. 103(a) as being obvious over Griebenow in view of Logan et al. (US005721827A, hereafter "Logan").

13. Griebenow does not teach calculating an amount of money to be earned by the user of the personal computer for self-distributing the content data. Logan teaches calculating an amount of money to be earned by the user of the personal computer for self-distributing the content data, inherently as revenue minus total costs, including sub-steps of:

determine revenue equal to service user charges, where said revenue/service user charges may vary with the amount of advertising accepted by the customers/*subscribers* (col. 9 lines 5-11),

retrieving data representing a number of times the content data was accessed by users (the *Plays field*, col. 19 line 63 to col. 20 line 1) of the application service provider,

determining an amount of money (*Amount*, col. 20 lines 1-20) that corresponds to the number of times the content data was accessed by users of the application service provider, and

determining an adjustment to the service user charges by depending on the amount of advertising accepted by the customers/*subscribers*, by subtracting the amount of money that corresponds to the number of times the content data was accessed by users of the application service provider from the service user charges (in the formula at col. 20 line 13).

Under *KSR v. Teleflex* (82 USPQ 2nd 1385), the combination of Logan with Griebenow would be obvious because prior art elements are being combined according to known methods to yield predictable results. It is obvious that the service provider/"user of the personal computer" would need to earn an amount of money for self-distributing the content data, and Griebenow teaches this amount of money as the *consumer bill*, but provides no details as to how said bill could be determined. Logan provides these details.

14. Neither Griebenow nor Logan teaches that the "amount of money" is determined in part by adding a connection fee of an Internet serviced provider. It would be obvious to do so when the information serviced provider/"user of the personal computer" was also providing Internet service.

Response to Arguments

15. Applicant's arguments filed with an amendment on 17 April 2008 have been fully considered but they are not persuasive. The revised rejection addresses applicant's arguments.

Conclusion

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

17. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached Monday, Wednesday morning, and after Noon on Thursday and Friday. The examiner can also be contacted by e-mail at

donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717.

19. The examiner's supervisor, James W. Myhre, can be reached on 571-272-6722.

20. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

21. **AFTER FINAL PRACTICE –** Consistent with MPEP § 706.07(f) and 713.09, prosecution generally ends with the final rejection. Examiner will grant an interview after final only when applicant presents compelling evidence that "disposal or clarification for appeal may be accomplished with only nominal further consideration" (MPEP § 713.09). The burden is on applicant to demonstrate this requirement, preferably in no more than 25 words. Amendments are entered after final only when the amendments will clearly simplify issues, or put the case into condition for allowance, clearly and without additional search or more than nominal consideration.

22. Applicant may have after final arguments considered and amendments entered by filing an RCE.

23. Applicant is advised that, unless a proposed amendment is filed after final and the examiner returns an advisory action with block 3(a) checked (signifying that further search or consideration is required), an amendment filed with an RCE **COULD BE MADE FINAL IN THE FIRST ACTION** in accordance with MPEP § 706.07(b).

24. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov.

At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

5 April 2009

/Donald L. Champagne/
Primary Examiner, Art Unit 3688